



## REMARKS

### ***Preliminary Matters/Objections***

The above amendments revise the title and correct various typographical errors and errors of form in the pending claims, and do not contain any new matter.

It is further drawn to the Examiner's attention that the precise claim count payment authorized in the transmittal letter sent June 16, 2000, August 17, 2001 and April 3, 2002 was incorrect. However, in all three of these letters, a general authorization to charge the requisite fees or credit overpayment was indeed authorized. As a result, while authorization was given for the proper payment, it is not clear if the requisite fees were in fact paid. For the record, Applicants desire to clarify and, if necessary, correct this procedural anomaly.

The Examiner has reiterated his objection to the specification because it contains an embedded hyperlink and/or other form of browser-executable code.

In response, Applicants have deleted the offending text.

### ***The Rejection under 35 U.S.C. 112, Second Paragraph***

Claims 4, 10 and 24 stand rejected under 35 U.S.C. § 112, Second Paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the invention.

Specifically, the Examiner argues that the term "stringent conditions" has not been precisely defined within the claim, and that while the specification defines stringent conditions as including a wash step, the claim language does not.

In response, Applicants have cancelled Claim 10 and amended Claims 4 and 24 to recite the wash step.

### ***The First Rejection under 35 U.S.C. § 112, First Paragraph***

Claims 1, 4, 5, 7, 10-19 and 24 stand rejected under 35 U.S.C. § 112, First Paragraph, as allegedly being enabling for a polynucleotides encoding a polypeptide having the amino acid sequence of SEQ ID NO:2 or antigenic fragments thereof, it does not enable amino acid variants of SEQ ID NO:2.

Specifically, the Examiner argues that the claim limitation added on April 3, 2002 "and wherein said polypeptide binds Gli" allegedly does not refer to the polynucleotide or polypeptide

that is being claimed. The Examiner also asserts that the specification does not teach variants of SEQ ID NO:2 having any particular function.

In response, Applicants have amended the claim language to precisely state that the ability to bind Gli is a function of the variant and not the reference sequence (SEQ ID NO:2). The Examiner's attention is further directed to the specification at page 11, lines 39-40, which specifies that the hSu(fu) molecules of the invention possess the ability to "modulate the Hedgehog signaling pathway, most preferably to modulate, activate or suppress fused activity." Finally, the name alone "Suppressor of fused" is indicative itself that the function is to antagonize fused activity.

Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1, 4, 5, 7, 10-19 and 24 under 35 U.S.C. § 112, First Paragraph.

***The Second Rejection under 35 U.S.C. § 112, First Paragraph***

Claims 1, 4, 5, 7, 10-19 and 24 stand rejected under 35 U.S.C. § 112, First Paragraph, allegedly as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled that the inventors had possession of the claimed invention.

Specifically, the Examiner argues that Applicants' Amendment of April 3, 2002, while attempting to require structural and functional limitations descriptive of the genus, failed to do so because the limitation "and wherein said polypeptide binds Gli" does not refer to the claimed polypeptide variant.

In response, the Amendments submitted herewith to the above claims more precisely specify that the limitation applies to the hu(Su)fu polypeptide variant and not to the SEQ ID NO:2 reference sequence.

Applicants respectfully request reconsideration and withdrawal of the rejection of Claims 1, 4, 5, 7, 10-19 and 24 under 35 U.S.C. § 112, First Paragraph.

***The rejection under 35 U.S.C. § 102***

Claim 10 is rejected under 35 U.S.C. § 102(b) as being anticipated by GenBank accession number AA061391, Marra *et al.*

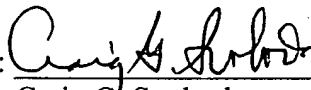
In response, Applicants respectfully submit that the rejection has been rendered moot by the cancellation of the claim.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "Version with markings to show changes made."

The examiner is invited to contact the undersigned at (650) 225-1489 in order to expedite the resolution of any remaining issues.

Respectfully submitted,  
GENENTECH, INC.

Date: Sept. 13, 2002

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